

REMARKS

Claims 1-28 are pending in the application. Claims 1 and 20 are amended by this Reply. Applicants respectfully submit that no new matter has been added by the amendment. On page 2 of the August 18, 2004 Office Action, the Examiner suggested that Applicants amend the independent claims of the present application "to move the content of the preamble into the claim body to make the claims more specific." The independent claims of the present application (claims 1 and 20) have been so amended, in accordance with the Examiner's suggestion.

Remarks Concerning Rejections Under 35 U.S.C. § 112

In the May 6, 2004 Office Action, the Examiner rejected Claims 10, 11, 12, 23 and 24 under 35 U.S.C. § 112 as failing to comply with the enablement requirement. In the Reply dated June 25, 2004, Applicant traversed that rejection and explained that the present application is sufficient to enable one skilled in the art to practice the invention without undue experimentation. In the August 18, 2004 Office Action, which is the subject of this Reply, the Examiner did not reiterate the § 112 rejections. Applicants therefore consider those rejections withdrawn.

Remarks Concerning Rejections Under 35 U.S.C. § 103

On page 3 of the August 18, 2004 Office Action, the Examiner rejected Claims 1-9, 13-22 and 26-28 as being unpatentable over U.S. Patent No. 5,790,664 to Coley et al. ("Coley") in view of U.S. Patent No. 6,038,486 to Saitoh et al. ("Saitoh")¹. In light of the amendments made herein to Claims 1 and 20, Applicants respectfully traverse that rejection.

¹ The Examiner makes reference to "U.S. Patent No. 5,790,604 to Cokey et al," but the '604 patent in fact issued to Kelton et al., in a field unrelated to the present invention. Judging from prior correspondence from the Examiner, it is believed that the Examiner intended to refer to U.S. Patent No. 5,790,664 to Coley et al. Applicants respectfully submit this Reply with the assumption that the Examiner's citation was mistaken.

Independent claims 1 and 20 are directed to a method and system, respectively, for monitoring a factory automation product via a communications network, wherein the factory automation product is installed at an installation site having an installation site address.

Specifically, claim 1 requires "searching the communications network by a monitoring mechanism for the installation site address." Claim 1 is also hereby amended to require "installing the factory automation product at an installation site having an installation site address." That limitation was previously in the preamble of the claim, and by this amendment is incorporated into the claim body.

Claim 20 requires "an installation site having an installation site address, the factory automation product being installed at the installation site, wherein the factory automation product includes identifiable information associated therewith." Similar to claim 1, that limitation was previously in the preamble of the claim, which is hereby amended to appear in the claim body. Claim 20 also requires "a search mechanism for searching the communications network for the installation site address by a monitoring mechanism," a limitation added by a prior amendment.

Neither Coley nor Saitoh discloses a monitoring mechanism for searching the communications network for an installation site address. Coley relates to a method for automatically tracking the use of software for determining whether the software is licensed. However, as the Examiner observed, Coley includes no teaching of a factory automation product in communication with the communications network. Additionally, Coley does not include any teaching that the communications network is searched for an installation site address. In fact, Coley does not describe an installation site address in any respect. Coley appears to presuppose that the information identifying the network devices is already known to the system (Coley, col. 7, ll. 43 et seq.). Otherwise, the transmission of software information from the device to the database described by Coley would be unhelpful to the user. In any event, Coley does not disclose a monitoring mechanism for searching the communications network for the installation site address.

Saitoh fails to cure the deficiencies of Coley. Saitoh relates to a method of operating, controlling, monitoring and analyzing the data of control devices. However, Saitoh includes no teaching of searching for information from a factory automation product, nor does Saitoh teach

identifying the factory products through the communications network. Additionally, Saitoh does not include any teaching of a monitoring mechanism for searching the communications network for an installation site address. Like Coley, Saitoh includes no disclosure of an installation site address.

In the present application, a factory automation product having identifiable information is installed at an installation site, which has an installation site address. *A monitoring mechanism searches a communications network for the installation site address*, and associates the factory automation product to the installation site address based on the identifiable information. Neither Coley nor Saitoh disclose that limitation, and therefore Applicants submit that the independent claims of the application (claims 1 and 20) are both distinguishable over the combination of Coley and Saitoh.

In addition to failing to disclose each of the limitations of the independent claims, the combination of Coley with Saitoh is improper because there is no motivation or incentive in the prior art to combine those references in the manner suggested by the Examiner. See *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995). Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combinations and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner bears the initial burden on factually supporting any *prima facie* conclusion of obviousness. See MPEP § 2142. In the present case, the

Examiner failed to meet this burden. Instead, the Examiner has simply concluded one skilled in the art would make the suggested modifications. This is insufficient.

Coley is from the field of using a communications network to track the use of a software product, to determine whether the product is licensed. Saitoh, on the other hand, is from the manufacturing device control field, with an emphasis on using a server to remotely control a factory device. On page 3 of the August 18, 2004 Office Action, the Examiner stated that it would have been obvious to combine Coley with Saitoh to include Saitoh's teachings of factory automation devices. However, that statement does not take into account the different purposes of Coley and Saitoh, nor does it consider the vastly different networks, protocols and systems addressed by those two patents. Further, Coley, and other prior art in the field of Coley, include no suggestion that the system provided by Saitoh would be helpful, advantageous, or operative if combined with Coley as suggested by the Examiner. As a result, there is no showing of any motivation to combine the references.

Instead, it appears the Examiner used hindsight in making the suggested combination. However, hindsight combination of references, using the present invention as a roadmap, is improper. It is well recognized that the claimed invention cannot be used as an instruction manual or template to piece together the teachings of the prior art in an attempt to render the claimed invention obvious. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

On pages 3 through 6 of the August 18, 2004 Office Action, the Examiner rejected certain dependent claims as also being unpatentable over the combined teachings of Coley and Saitoh, namely claims 2-9, 13-19, 21-22 and 26-28. Because the independent claims are both distinguishable over Coley and Saitoh for the reasons mentioned above, and further because there is no motivation to combine those two patents, the dependent claims of the application are therefore distinguished over Coley and Saitoh as well.

Applicants therefore respectfully request that the § 103 rejection based on the Coley and Saitoh references be withdrawn.

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Reply to Office Action of August 18, 2004

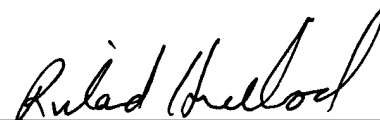
Conclusion

In light of the remarks made herein, Applicants submit that Claims 1-28, as amended, are in condition for allowance. No new matter has been added by this amendment. Applicants respectfully request the Examiner to withdraw the rejections and allow the claims to issue. If it may be of assistance to contact the Applicants regarding the present application, the Examiner is invited to do so. The Commissioner is authorized to charge Deposit Account No. 23-0280 in connection with any fees associated herein.

Respectfully submitted,

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service, with first class postage prepaid, in an envelope addressed to: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 18, 2005



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